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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/624,923  | 07/22/2003  | Akira Kashiwagi      | 89277.0004          | 7123             |
| 26021   | 7590        | 02/17/2005           | EXAMINER            |                  |
| HOGAN & HARTSON L.L.P.<br>500 S. GRAND AVENUE<br>SUITE 1900<br>LOS ANGELES, CA 90071-2611 |             |                      | NEGRON, ISMAEL      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2875                |                  |

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,923

Applicant(s)

KASHIWAGI, AKIRA

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7, 9-11, 13, 14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 9-11, 13, 14 AND 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on January 24, 2005 has been entered. Claims 1, 5, 7, 11, 13, 14 and 17 have been amended. Claims 2, 6, 8, 12 and 5-16 have been cancelled. No claim has been added. Claims 1, 3-5, 7, 9-11, 13, 14 and 17-21 are still pending in this application, with claims 1, 5, 11 and 14 being independent.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 7, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHWALLER et al. (U.S. Pat. 5,384,693).

SCHWALLER et al. discloses a vehicle illumination device having :

- **a tail lamp (as recited in claims 1, 5 and 14)**, column 1, lines 32-35;
- **the tail lamp being attached to a rear fender (as recited in claims 1 and 5)**, column 3, lines 22 and 23;
- **a lamp substrate (as recited in claims 1, 5 and 14)**, Figure 1, reference number 4;

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- **a plurality of light emitting elements (as recited in claims 1, 5 and 14)**, Figure 1, reference numbers 2 and 3;
- **the light emitting elements being mounted on the substrate (as recited in claims 1, 5 and 14)**, column 2, lines 9 and 10;
- **the light emitting elements extending generally perpendicular to the substrate (as recited in claims 1, 5 and 14)**, as seen in Figure 4;
- **the substrate being disposed along a rearwardly descending surface of the fender (as recited in claims 1 and 5)**, as evidenced by Figure 3, and column 3, lines 22 and 23;
- **the light emitting elements extending upwardly and diagonally relative to a horizontal direction (as recited in Claim 1)**, as seen in Figure 4;
- **at least one lens (as recited in claims 1, 5 and 14)**, Figure 3, reference number 6;
- **the lens covering the plurality of light emitting elements (as recited in claims 1, 5 and 14)**, column 2, lines 13-15;
- **the lens having directivity to rearwardly direct light from the light emitting elements (as recited in claims 1, 5 and 14)**, column 2, lines 13-15;

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- **the lens directing light from the light emitting elements generally in the horizontal direction (as recited in claims 1, 5 and 14), as evidenced by Figure 3;**
- **the light emitting elements being light emitting diode (LED) elements (as recited in claims 3, 7 and 18), column 2, lines 8 and 9;**
- **a housing (as recited in Claim 14), column 2, line 13;**
- **the substrate being fastened to the housing (as recite in Claim 14), column 2, lines 11-13;**
- **the substrate being tilted from the vertical line when the housing is mounted on the vehicle (as recited in Claim 14), as evidenced by Figure 3;**
- **the housing having a concave section protruding rearwardly from a bottom surface of such housing (as recited in Claim 14), as seen in Figure 3;**
- **a circuit substrate (as recited in Claim 14), as evidenced by Figure 4;**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in Claim 14), as evidenced by Figure 4; and**

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- **the light emitting elements emitting light diagonally with respect to a horizontal direction (as recited in Claim 17), as seen in Figure 3.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 9-11, 13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHWALLER et al. (U.S. Pat. 5,384,693).

SCHWALLER et al. discloses a vehicle illumination device having:

- **a tail lamp (as recited in claims 1, 5 and 14), column 1, lines 32-35;**
- **the tail lamp being attached to a rear fender (as recited in claims 1 and 5), column 3, lines 22 and 23;**
- **a lamp substrate (as recited in claims 1, 5 and 14), Figure 1, reference number 4;**
- **a plurality of light emitting elements (as recited in claims 1, 5 and 14), Figure 1, reference numbers 2 and 3;**

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- **the light emitting elements being mounted on the substrate (as recited in claims 1, 5 and 14), column 2, lines 9 and 10;**
- **the light emitting elements extending generally perpendicular to the substrate (as recited in claims 1, 5 and 14), as seen in Figure 4;**
- **the substrate being disposed along a rearwardly descending surface of the fender (as recited in claims 1 and 5), as evidenced by Figure 3, and column 3, lines 22 and 23;**
- **the light emitting elements extending upwardly and diagonally relative to a horizontal direction (as recited in Claim 1), as seen in Figure 4;**
- **at least one lens (as recited in claims 1, 5 and 14), Figure 3, reference number 6;**
- **the lens covering the plurality of light emitting elements (as recited in claims 1, 5 and 14), column 2, lines 13-15;**
- **the lens having directivity to rearwardly direct light from the light emitting elements (as recited in claims 1, 5 and 14), column 2, lines 13-15;**
- **the lens directing light from the light emitting elements generally in the horizontal direction (as recited in claims 1, 5 and 14), as evidenced by Figure 3;**

- **the substrate being disposed along a rearwardly descending surface of the fender (as recited in claims 1, 5 and 11), as evidenced by Figure 3, and column 3, lines 22 and 23;**
- **the light emitting elements being light emitting diode (LED) elements (as recited in Claim 13), column 2, lines 8 and 9;**
- **a housing (as recited in Claim 14), column 2, line 13;**
- **the substrate being fastened to the housing (as recite in Claim 14), column 2, lines 11-13;**
- **the substrate being tilted from the vertical line when the housing is mounted on the vehicle (as recited in Claim 14), as evidenced by Figure 3;**
- **the housing having a concave section protruding rearwardly from a bottom surface of such housing (as recited in claims 11 and 14), as seen in Figure 3;**
- **a circuit substrate (as recited in claims 11, 14 and 19), as evidenced by Figure 4;**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in claims 11 and 14), as evidenced by Figure 4;**
- **circuit elements (as recited in claims 4, 9 and 19), Figure 4, reference numbers 100 and 102;**



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- **the circuit elements being for the light emitting elements (as recited in claims 4, 9 and 19), as seen in Figure 4;**
- **the circuit elements being mounted on the circuit substrate (as recited in claims 4, 9 and 19);**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in claims 10 and 14), as evidenced by Figure 4; and**
- **the circuit substrate being enclosed in the concave portion of the housing (as recited in Claim 20), as evidenced by figures 3 and 4.**

SCHWALLER et al. discloses all the limitations of the claims, except the rear fender having a mounting concave section for receiving the concave section of the housing (as recited in claims 4, 9 and 19).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to mount the vehicle illumination device of SCHWALLER et al. in a rear fender having a concave section for receiving the concave section of the illumination device to increased the aesthetic value of the rear fender and achieving a more streamlined structure.

#### ***Response to Arguments***

4. Applicant's arguments filed January 24, 2005 have been fully considered but they are not persuasive.

5. Regarding the Examiner's rejection of claims 1, 5 and 14 under 35 U.S.C. 102(b) as being anticipated by SCHWALLER et al. (U.S. Pat. 5,384,693), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the light emitting elements extending upwardly and diagonally relative to a horizontal direction, such elements having a directivity that rearwardly directs light generally in the horizontal direction, or the lens having a directivity that causes the light emitted by the light emitting elements to be directed in a horizontal direction.

6. In response to applicant's arguments that SCHWALLER et al. fails to disclose the light emitting elements extending upwardly and diagonally relative to a horizontal direction, the applicant is respectfully directed to Figure 4 of the cited reference. SCHWALLER et al. discloses a substrate 4 supporting a plurality of light emitting elements 1-3. Element 1 extends substantially perpendicularly from the substrate 4, while elements 2 and 3 extend generally perpendicularly and slightly upwardly. Light from the light emitting elements 1-3 will be projected rearwardly in a generally horizontal direction, as claimed.

Applicant argues that of light emitting elements 1-3 only one (light emitting element 1) extends perpendicular to substrate 4, the Examiner disagrees. Light emitting element 1 is the only element having a longitudinal axis (emphasis added) perpendicular to the substrate 4, however, light emitting elements 2 and 3, while having a longitudinal axis inclined with respect to substrate 4, they do extend in a generally perpendicular direction from such substrate 4. In addition, even if light emitting

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elements 2 and 3 were considered as not extending perpendicularly from substrate 4, light emitting element 1 still does. Providing a plurality of light emitting elements such as light emitting element 1 to the patented structure of SCHWALLER et al. would merely amount to mere duplication of the light emitting element 1, such duplication involving only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. One of ordinary skill would have been motivated to increase the illumination output of the patented device of SCHWALLER et al.. In fact, SCHWALLER et al. suggests such modification in column 2, lines 56-61, specifically stating the advantages of having additional light emitting elements 1'.

Regarding the lens having a directivity that causes the light emitted by the light emitting elements to be directed in a horizontal direction, as explained in the previous section, the light emitting elements 1-3 of SCHWALLER et al. emit light in a horizontal direction, the lens 6 being transparent (column 2, lines 13-15) with a front face generally perpendicular with respect to a horizontal direction. Such lens would effect substantially no change in the direction of the light emitted by the light emitting elements 1-3, broadly meeting the claimed limitation reciting causing the light emitted by the light emitting elements to be directed in a horizontal direction.

7. Regarding the use of phrases like "mountable on a rear fender" (e.g. in Claim 1, line 1) or "attached to the rear fender" (e.g. in Claim 1, lines 3) the applicant is advised that it has been held by the courts that the recitation that an element is capable of performing a function is not a positive limitation, but only requires the ability to so

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perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In addition, it has also been held by the courts that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In this case, the rear fender of a motorcycle refers to the intended use of the claimed invention, and fails to patentably distinguish the claimed invention from the prior art as it result in no structural difference between the claimed invention and the prior art in order to. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

While applicant might argue that the claimed invention is a "rear fender including a tail lamp device", the fact is that the subject matter of the invention, as recited by the claims, is a tail lamp capable of being mounted on a motorcycle rear fender (emphasis added).

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negrón whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

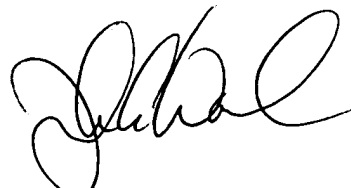
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

  
Inr

February 10, 2005

  
**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**